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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,019	03/16/2000	Frampton E. Ellis III	54869.0000095	1601

21302            7590            01/02/2002

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 01/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

65

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/527,019	ELLIS, FRAMPTON E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anthony D Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 October 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 11-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 11-44 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the mechanical fasteners, a snap fit and "combinations thereof", as stated in claim 4 and the computer control specifics of claim 14, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The drawings submitted on October 5, 2001 have been received. The changes to the existing drawing have been approved but the addition of drawing 11Q, being a schematic drawing of the claimed subject matter does not clearly show what applicant is claiming, especially the "combinations thereof". Therefore, this drawing will not be entered.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. Furthermore, some or much of the subject matter disclosed appears to be entirely outside the bounds of the claims and is therefore unnecessary to support the instant invention. Under provisions of MPEP 1302.01, the applicant is requested to modify the application to restrict the descriptive matter and Figures so as to be in harmony with the claims. Currently, it appears that only Figures 11A-11R support the instant invention.

### ***Claim Rejections - 35 USC § 112***

3. Claims 11-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims include the term "non-orthotic" which renders the claim so. Although the applicant has defined "non-orthotic" in the specification, the definition of a term cannot be contrary to

Art Unit: 3728

the known meaning of the term. The term orthotic, when referring to shoes, refers to anything that gives support to the foot. Since the applicant's "invention" would give support to the user's foot, it would meet the known definition of being an orthotic. Therefore, it is unclear what applicant is trying to claim as a "non-orthotic". Applicant's definition in the specification of "non-orthotic" would meet the broad definition of the term orthotic and therefore there appears to be no difference between the two.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanzi 4,706,316. Tanzi '316 discloses all the limitations of the claims including the following: a removable midsole portion 12 sized to fit inside and form part of the sole of a shoe (the sole of the shoe being 18, 14, 12); a secondary outer sole 14 on at least a portion of the midsole (14 can provide traction by itself or can also have attachments to it that could provide traction. The providing traction is functional language and is given little patentable weight since the structure of an outer sole is present in the reference.); a device (upper 10 to which 12 and 14 are fastened) associated with the midsole for retaining the midsole on the user's foot when the midsole is not placed within the receiving shoe; an insole (that sole of the upper 10 located on top of 12); the device 32 being an upper (as it is located above the sole and attaches to the upper portion of the user's foot).

6. Claims 25-44 are rejected under 35 U.S.C. 102(b) as being anticipated by the international reference WO 97/4612 (WO '612). WO '612 discloses all the limitations of the claims including the

Art Unit: 3728

following: an removable midsole portion 12 sized to fit inside a shoe (see Figure 22); the removable midsole portion including an inner surface (that area where one places one's foot upon); an outer surface (that facing the outsole 14); the midsole having a medial and a lateral side (see Figure 22); a plurality of protrusions (74, 76, 78) on at least one side of the midsole that interacts with the shoe (via protrusions 62, 64, 66 with 74, 76 and 78 inserted in these protrusions, respectively) to retain the insole within the shoe; at least one portion of the outer surface of each protrusion is concavely rounded (see Figure 22) relative to an inner section of the insertable midsole directly adjacent to the concavely rounded portion (protrusions are rounded inwardly); at least one portion of an inner surface of a side of the insertable midsole orthotic is convexly rounded relative to a section of the insertable midsole orthotic directly adjacent to the convexly rounded inner surface portion (see Figure 22, the protrusion has an outwardly rounded protrusion that has an inner surface that is convex and the outer surface that is concave); the midsole is insertable in the shoe (see figure 22, shows midsole being inserted into the shoe); protrusions are located on either side of the midsole (see Figure 19); the protrusions are located in an area near the longitudinal arch (see Figure 22); the midsole tapers on both sides of the protrusion (see figure 22, tapering occurs between each protrusion); tapered portion can be considered an indentation as 74, 76 and 78 are considered protrusions, depending on one's perspective or reference point; portion of side of shoe upper attached directly to the bottom sole 14 (shown in Figures 20-21) and shoe upper abuts at least a portion of the outer surface of the midsole (after midsole is placed within the shoe as shown in figure 22); at least two protrusions of the orthotic abut the bottom sole (74, 76 and 78 placed within 62, 64 and 66, thereby meeting this limitation in the claim); concavely rounded portions of midsole form protrusions (see Figure 22); at least two recess in the bottom sole (those formed by the interior of 62, 64 and 66) to releasably retain the insertable midsole; the outer surface of the protrusions on the outer sole (62, 64 and 66) is concavely rounded to an inner section of the bottom sole adjacent to the concavely rounded section of the bottom sole (similar to that of protrusions of

Art Unit: 3728

midsole described above); inner surface of the protrusions of the bottom sole also similar to the inner surface of the protrusions of the midsole described above; protrusions of bottom sole located on either side of shoe (to fit protrusions of midsole shown in Figure 19); thickness of protrusions of bottom sole taper in similar fashion to that of protrusions of midsole (see Figure 20).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanzi 4,706,316 in view of Demon 5,813,142. Tanzi '316 discloses all the limitations of the claim except for the compartment containing a fluid, a flow regulator a duct, a control system that automatically adjusts the pressure in the compartment, and a microcomputer. Demon '142 teaches that a shoe sole can be modified to contain a compartment containing a fluid, a flow regulator, a duct, a control system automatically adjusting the pressure in the compartment, and a microcomputer, substantially as claimed. Therefore, it would have been obvious to provide the shoe midsole of Tanzi '142 with the system of Demon 142 to reduce the impact of the user's foot on the traveling surface during use.

9. Claims 14-20 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanzi 4,706,316 as applied to claim 41 above in view of WO 97/4612 (WO '612). Tanzi '316 discloses all the limitations of the claims except for the limitations with respect to the protrusions and concave and convex portions. WO 97 '612 teaches that a midsole can have the following: at least one portion of the outer surface of each protrusion is concavely rounded (see Figure 22) relative to an inner section of the

Art Unit: 3728

insertable midsole directly adjacent to the concavely rounded portion (protrusions are rounded inwardly); at least one portion of an inner surface of a side of the insertable midsole orthotic is convexly rounded relative to a section of the insertable midsole orthotic directly adjacent to the convexly rounded inner surface portion (see Figure 22, the protrusion has an outwardly rounded protrusion that has an inner surface that is convex and the outer surface that is concave); the midsole is removable from the shoe (see figure 22, shows midsole being inserted into the shoe; the midsole tapers on both sides of the protrusion (see figure 22, tapering occurs between each protrusion); and the shoe upper being attached directly to the bottom sole such that the shoe upper abuts at least a portion of the outer surface of the inner midsole. These protrusions formed on the orthotic of WO '612 are formed so as to fasten the midsole within the outsole and upper of the shoe. Therefore, it would have been obvious to place such protrusions, as taught by WO '612, on the midsole of Tanzi '316, to aid in releasably fastening the midsole of Tanzi '316 to the sole, as taught by WO '612.

#### *Double Patenting*

10. Claims 11-44 of this application conflict with claims 11-45 of Application No. 09/558,629. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

Art Unit: 3728

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 11-44 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11-45 of copending Application No. 09/558,629. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented and since it has been determined that there appears to be no difference between the terms "orthotic" and "non-orthotic" and the terms "removable" and "insertable" are interchangeable. Also, applicant's arguments admits that the terms "orthotic" and "non-orthotic" are not structurally different.

#### *Response to Arguments*

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### *Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3728

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

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Art Unit: 3728



Anthony D Stashick  
Examiner  
Art Unit 3728

ADS

December 28, 2001